

REMARKS

Claims 1-10 were pending in this application. With entry of this Amendment, claims 1-4 and 7-8 are amended; and claims 11-19 are added. Thus, claims 1-19 are now pending. Support for these new claims is found throughout the originally-filed specification and claims, see for example, pages 6-8; Example 1; page 12, lines 11-14; and other similar teachings. Applicants note that new claims 15-19 are directed to individual steps recited in the method of claim 1, and the direct products resulting from those steps. Claims 11-14 recite a sub-step of wounding the explant in the method of claim 1. All of these added claims ultimately depend from independent claim 1. Thus, no additional search burden is imposed on the Examiner to consider these new dependent claims in conjunction with the previously pending independent claim.

Objection to the Specification

Applicants have updated the priority information and references to U.S. patent applications in the specification, as requested by the Examiner.

Rejections under 35 USC §112

The Examiner rejected claims 1-10 under 35 USC §112, second paragraph, as allegedly being indefinite. Applicants have amended the claims to clarify the claimed invention in accordance with the Examiner's suggestions.

Rejections under 35 U.S.C. §103(a)

The Examiner rejected claims 1, 2, 7-9, under 35 USC §103(a) as allegedly being unpatentable over Hanson *et al.* (U.S. Patent No. 5,286,635). To establish a *prima facie* case of obviousness, there must be some suggestion or motivation to modify the teachings of the cited prior art in the manner proposed by the Examiner; there must be a reasonable expectation of

success from so doing; and the prior art must teach or suggest all of the elements of the claim.

M.P.E.P. §2143. Applicants contend that the Examiner has failed to establish a *prima facie* case of obviousness.

According to the Examiner, Hanson describes a method of transforming the embryonic axis of a pea using *Agrobacterium*. Office Action, page 3. As the Examiner acknowledges, however, Hanson is directed to a method of transforming pea, whereas the present claims are directed to soybean. *Id.*, page 4. In addition, Hanson does not teach or suggest transforming an explant that includes the embryonic meristem (see applicants specification page 6, lines 2-24). Thus, the cited prior art fails to teach each element of the presently amended claims.

Furthermore, there is no motivation to modify Hanson to derive the missing claim element. Quite to the contrary, Hanson teaches that that the meristem tissue should be removed because, among other things, it “lead[s] to nontransformed shoots developing.” See Hanson, column 4, lines 22-34. Following these teachings, one of skill in the art would be motivated to discard the meristem tissue to avoid the transformation problems identified by Hanson. Consequently, there is no motivation to modify the teachings of Hanson to use meristem tissue in the transformation. Nor is there any reasonable expectation of success, as Hanson teaches that meristem tissue will not work in the transformation and should be avoided.

In view of these deficiencies in the cited prior art, Applicants contend that the Examiner has not established a *prima facie* case of obviousness and respectfully request that the rejection be withdrawn.

The Examiner also rejected claims 1-10 under 35 USC §103(a) as allegedly being unpatentable over Hanson *et al.* (U.S. Patent No. 5,286,635) in view of Barry *et al.* (U.S. Patent

No. 5,463,175) and Martinell *et al.* (U.S. Patent No. 5,914,451). Applicants respectfully traverse this rejection.

Hanson is discussed above. Neither the addition of Barry nor Martinell provide the teachings missing from Hanson that would render the claimed invention obvious. Barry teaches a gene encoding a protein capable of conferring tolerance to glyphosate. Martinell describes particle bombardment-mediated (biolistics or gun) methods for transforming soybean. None of the cited prior art, alone or in combination with Hanson, teaches or suggests the method of transforming explants including the meristem with *Agrobacterium*, as claimed by Applicants. Accordingly, Applicants respectfully request that the rejection be withdrawn.

Double Patenting Rejection

The Examiner rejected claims 1-10 under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,384,301. Applicants are amenable to filing a terminal disclaimer to obviate this rejection, but wish defer the filing of a terminal disclaimer until there is an affirmative indication of allowable subject matter in this application.

Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of the present application. The Examiner is encouraged to call the undersigned should any further action be required for allowance.

Respectfully submitted,



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